

## **REMARKS**

### **1. Examiner's Interview**

The undersigned attorney appreciates the telephonic interview provided by Examiner Woo on October 13, 2009. The parties discussed:

- A proposed amendment to claim 72 to address the 35 USC §112(2) rejections, with the proposed amendment being reflected in the foregoing pages (wherein the matter of claim 72 is amended into claim 68); and
- A proposed amendment to claim 51 to address the 35 USC §102(e) rejections in view of U.S. Patent 6,994,713 to *Berg*, with the proposed amendment being reflected in the foregoing pages.

It is the undersigned attorney's understanding that the amendments should be sufficient to overcome the rejections. However, further discussion is welcomed if such is needed.

### **2. The Amendments and the Support Therefor**

Four claims (72, 76-78) have been canceled, no new claims have been added, and claims 51, 62, 64, and 68 have been amended to leave claims 51, 53, 55-64, 67, 68, 70, 71, 73-75, and 79-84 in the application. No new matter has been added by the amendments, which are discussed in greater detail below.

### **3. Sections 1-2 of the Office Action: Rejection of Claims 76-78 Under 35 USC §101**

Claims 76-78 are canceled to obviate these rejections.

### **4. Sections 3-4 of the Office Action: Rejection of Claims 62 and 72 under 35 USC §112**

Claim 62 is amended as suggested in Section 4 of the Office Action, and the rejection of claim 62 is therefore believed to be overcome.

Claim 72, now incorporated into claim 68, has been amended to address the antecedent basis issue in the manner discussed during the aforementioned Interview.

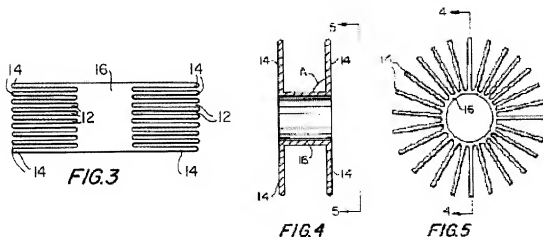
**5. Sections 5-6 of the Office Action: Rejection of Claims 51, 53, 55-61, 63, 70, 73, and 79 under 35 USC §102(e) in view of U.S. Patent 6,994,713 to Berg**

Claim 51 has been amended as discussed in the Interview to more clearly indicate that:

the resilient member has a cross-sectional area at least substantially equal to the greater of:

- i. the *sums of the cross-sectional areas* of the first parts when the first parts are in their open configuration, and
- ii. the *sums of the cross-sectional areas* of the second parts when the second parts are in their open configuration.

As amended, claim 51 clearly distinguishes from *Berg*, wherein the resilient member (16) has a cross-sectional area which is clearly significantly greater than the sums of the cross-sectional areas of the first parts (14), and also the sums of the cross-sectional areas of the second parts (14):



Further, it would not be obvious to one of ordinary skill in the art to “shrink” the member 16 – which defines a port – to have the same or similar diameter as the collected fingers 14. If this were done, *Berg* would no longer function for its intended purpose of splicing a port or graft into the wall of a vessel as shown in FIG. 8 of *Berg* (or FIGS. 15, 22, etc.). See MPEP 2143.01 (subsection entitled “The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose”). Thus, if the prior art is objectively reviewed without prior knowledge of the invention (i.e., without hindsight), it is seen that the teachings of the art do not lead one to contemplate the presently-claimed invention.

Regarding *dependent claims 56 and 61*, which recite that the device is formed of wire, this structure is plainly not shown or suggested by *Berg*. The Office Action asserts that

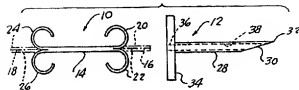
"wire" can be defined to include "metal in the form of a usu. very flexible thread or slender rod." And given the broadest reasonable interpretation of "wire," *Berg's* structure, as shown in fig. 13, can be said to comprise slender rods of metal.

This is plainly not the case; FIG. 13 simply shows a medial tube 16 which is perforated, with fingers 14 extending therefrom, and neither the fingers nor the medial tube would define a "thread" or a "rod". Consider column 4 lines 1-26, describing how *Berg's* devices are made by cutting the tube of FIG. 1 "substantially axially at many locations 12 spaced circumferentially around each axial end portion as shown in FIG. 3. Cuts 12 reduce starting tube 10 to a plurality of fingers 14 extending substantially axially from each end of an uncut medial tube portion 16." Consider that cutting tube walls in this manner would result in planar (actually curved) sections bounded by cut edges (which would not be rounded). The FIG. 13 device is therefore not formed of wire, "thread," or "rods"; no ordinary artisan would regard it as being made of wire; and no ordinary artisan would contemplate forming it of wire. Further consider that it is unknown how *Berg's* medial tubular portion 16 could be formed of wire with any reasonable expectation of success.

**6. Section 7 of the Office Action: Rejection of Claims 51, 64, 67, 68, 74, 75, 80, 81, 82, and 84 under 35 USC §102(b) in view of U.S. Patent 3,527,223 to *Shein***

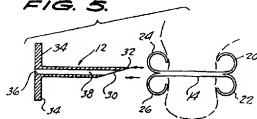
Claims 51 and 64 have been amended to clarify that at least one of the tips of the first and second parts is sharpened, a feature which is not shown in, or obvious in view of, *Shein* (as the Office Action appears to implicitly recognize at Page 8). To review, U.S. Patent 3,527,223 to *Shein* does not have any sharpened surfaces, and it uses a sharpened hollow insertion needle (12 in FIG. 1) which is used to pierce the earlobe, after which the ear stud 10 can be inserted through the needle 12 (and through the earlobe), with removal of the needle 12 then leaving the stud 10 in place:

**FIG. 1.**



The first and second parts/ends of *Shein's* stud 10 are not sharpened – nor are the surfaces therebetween – and there would not be any motivation to sharpen them because this would cause pain to the wearer. Consider the effect in *Shein's* FIG. 5, showing the body 14 of the stud 10 within an earlobe (shown in phantom lines), if the first and second parts/ends of *Shein's* stud 10 were sharpened: the sharp ends would bear against, and cut into, the earlobe.

**FIG. 5.**



This is why *Shein* utilizes the separate hollow needle 12. Note that use of such a needle would be disadvantageous for installing a graft in an artery since it would punch a larger hole in the graft and artery wall than is necessary to install the fixator. The end result is that one would have loose (and potentially leaky) fixation. In contrast, the claimed invention may both pierce and fix a graft on an artery with the fixator creating no greater hole than necessary.

Claim 68 is amended to incorporate claim 72 (which was indicated as allowable subject to remediation of the §112(2) issues, which have been addressed), and thus claim 68 should be allowable.

**7. In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



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